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#6 JMA 8/12/03

Docket No. 66307/JPW/FHB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Wen Dong Song et al.

U.S. Serial No. : 10/059,940 Examiner: M. Alexandra Elve

Filed : January 29, 2002 Group Art Unit: 1725

For : METHOD AND APPARATUS FOR DEFLASHING OF INTEGRATED CIRCUIT PACKAGES

1185 Avenue of the Americas
New York, New York 10036
August 1, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO JULY 1, 2002 OFFICE ACTION

This Communication is submitted in response to the Office Action issued by the U.S. Patent and Trademark Office on July 1, 2003 in connection with the above-identified application. A response to the July 1, 2003 Office Action is due August 1, 2003. Accordingly, this Response is being timely filed.

In the July 1, 2003 Office Action, the Examiner required restriction to one of the following allegedly independent and distinct inventions characterized by the following Groups I-II:

I. Group I, claims 1-14 and 24, drawn to a method of deflashing IC packages, classified in class 219, subclass 121.72;

II. Group II, claims 15-23 and 25, drawn to an apparatus for deflashing IC packages, classified in class 219, subclass 121.68;

The Examiner asserted that the inventions of Groups I and II are related as product and apparatus of its practice. Inventions in this relationship can be shown to be distinct if (1) the process for using the product as claimed can be practiced by another materially different apparatus or by hand or (2) the apparatus as claimed can be used to practice another materially different process as set forth in MPEP §806.05(e). The Examiner alleged that the apparatus can be used for surface cleaning, for example, or removing particulate material from the surface of an optical disc. For these reasons, the Examiner asserted that these Groups are patentably distinct.

In response, applicants hereby elect, with traverse, the claims of Group I, specifically claims 1-14 and 24.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application.

First, the inventions of the cited Groups are not independent. Under MPEP §802.01, "independent" means there is no disclosed relationship between the subjects disclosed. Group I claims a method of deflashing IC packages. Group II claims an apparatus for deflashing IC packages. Thus, Groups I and II are necessarily related. The Applicants therefore maintain that the claims of these cited Groups are not "independent".

Furthermore, under MPEP §803, there are two criteria for a proper restriction requirement: 1) the invention must be independent or distinct (discussed above), and 2) there must be a serious burden on the Examiner if restriction is required. MPEP §803 unambiguously provides that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction is not required between Groups I and II because a search for prior art material to the patentability of the claims of Group I would necessarily turn up the prior art material to the patentability of the claims of the remaining Group. Since there is no burden on the Examiner to examine Groups I and II together in the subject application, it is therefore submitted that the Examiner should examine the claims of both Groups on the merits.

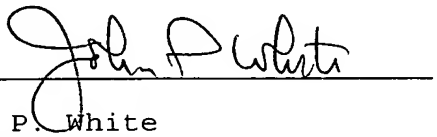
SUMMARY

In view of the foregoing, applicants maintain that the July 1, 2003 restriction requirement is not proper under 35 U.S.C. § 121 and respectfully request that the Examiner reconsider and withdraw the requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

8/1/03

John P. White
Reg. No. 28,678

Date